



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,638	08/16/2001	Quintin T. Phillips	10006504-1	6319

7590 08/24/2005
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,638

Applicant(s)

PHILLIPS, QUINTIN T.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment received on 5/6/2005 is acknowledged and entered. Applicant has added new claims 24-30. Currently claims 9-30 are pending for examination.

Response to Arguments

2. Applicant's arguments filed on 5/6/2005 (see Remarks, pages 6-10) have been fully considered but they are not persuasive for following reasons.

The applicant argues concerning claim 9 that Sekizawa does not disclose including a request in the status information sent by agent 10 to mail server 19. The examiner respectfully does not agree. A request is an act of asking or sending a message for something to be done or given. The status information sent by agent unit 10 includes message about the abnormal state of the machine (see at least col.5, lines 32-50) which requires maintenance ending up in providing services and dispatching maintenance personnel.

The applicant further argues concerning claim 9 that Sekizawa does not disclose, "receiving a message responsive to the communicating the request and communicating the message using the image forming device". The examiner respectfully disagrees. Sekizawa teaches that the integrated monitor unit "20" installed in an agency selling printers (col.19, lines 6-14) communicates to the printer user a warning message about the abnormal state of the printer (see at least col.5, lines 32-50).

Concerning claim 10, the applicant argues that Sekizawa does not disclose accessing a condition associated with an operation of the image forming device from the consumable. The examiner respectfully disagrees because Sekizawa does disclose accessing a condition associated with an operation of the image forming device from the consumable, see at least col.9, lines 12-40, “ *The integrated monitor unit thus configured periodically gets and retains the status information containing remaining amount information of a consumable article of the machine to be monitored such as a printer (for example, ink, toner, or an ink ribbon) and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information.....* ”, and col.16, line 64-col.17, line 9, which discloses receiving status information via a computer of a printing machine as regards to a balance amount of different consumables, such as ink, toner, ink-ribbon left in the machine. Accessing condition of different variables, that is status information separately from different consumables, such as ink, toner, ink-ribbon corresponds to accessing a condition associated with an operation of the image forming device from the consumable.

Concerning the applicant's arguments regarding claims 11-15, the examiner refers to refers to at least col.9, lines 12-40, “ *The integrated monitor unit thus configured periodically gets and retains the status information containing remaining amount information of a consumable article of the machine to be monitored such as a printer (for example, ink, toner, or an ink ribbon) and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information.....* ”, and col.16, line 64-col.17, line 9 which disclose monitoring and accessing the condition related to the balance amount of different consumables, see at least col.5, lines 32-50, which discloses monitoring and

Art Unit: 3625

accessing a condition of an abnormal state or fatal error requiring maintenance personnel and not related to the status of consumable. Sekizawa discloses monitoring and accessing the operating conditions of printers for their life span (see at least col.2, lines 43-49). Sekizawa also discloses monitoring and accessing the condition of more than one consumable, that is ink, ribbon, and toner.

Concerning claim 16, the applicant's arguments are not persuasive because the status information 01, which includes the request message as analyzed above, does include the printer registration log file and further see at least col.35, lines 16-27 which teaches selecting an unread message from a plurality of messages based upon the identity of the printer.

Regarding claim 17 and its dependencies 18-23 the applicant's arguments are not persuasive for the same reasons and analysis as presented above for claims 9-14 and 16.

In view of the foregoing the rejection of claims 9-23 is sustainable as anticipated by Sekizawa.

Objection to Specification

3. The amendment filed on 5/6/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 27, which is a dependency of claim 9, and therefore its limitation, that is " wherein the communicating the message comprises printing the message upon paper " implies that

Art Unit: 3625

the message received in response to the communicated request of claim 9 is printed upon paper using the image forming device and this subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Further, if the image forming device is short of ink or toner or in a fatal breakdown it is unclear how this image forming device can print a message upon the paper.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 27, which is a dependency of claim 9, and therefore its limitation, that is " wherein the communicating the message comprises printing the message upon paper " implies that the message received in response to the communicated request of claim 9 is printed upon paper using the image forming device and this subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

Art Unit: 3625

application was filed, had possession of the claimed invention. Further, if the image forming device is short of ink or toner or in a fatal break-down it is unclear how this image forming device can print a message upon the paper.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9-24 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated
Sekizawa (US Patent 6,430,711 B1).

Note: Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Art Unit: 3625

Regarding claims 9 and 17, Sekizawa discloses a marketing method comprising:

accessing a condition associated with an operation of an image forming device configured to use a consumable to form a hard image; monitoring the operation of the image forming device; communicating a request externally of the image forming device using the image forming device and responsive to the monitoring; receiving a message responsive to the communicating the request; and communicating the message using the image forming device (see at least col.18, line 45-col.19, line 44 and Fig.1 which reads on the recited limitations of claim 1. The monitor system of Fig.1 displays printers (p1....pn), which correspond to an image forming device using consumables, and further include agent units "10" which monitor the printer's operation. The agent unit accesses and monitors the operating conditions and status of the consumables (see col.19, lines 21-35), communicates a request and a message externally to unit "20", which receives the message. Unit 20 corresponds a unit of marketing system as it organizes delivery schedules of consumables (see at least col.19, lines 36-42). Note: A request is an act of asking or sending a message for something to be done or given. The status information sent by agent unit 10 includes message about the abnormal state of the machine (see at least col.5, lines 32-50) which requires maintenance ending up in providing services and dispatching maintenance personnel. Sekizawa teaches that the integrated monitor unit "20" installed in an agency selling printers (col.19, lines 6-14) communicates to the printer user a warning message about the abnormal state of the printer (see at least col.5, lines 32-50).

Regarding claims 10 and 18, Sekizawa discloses that in the method of claim 9 the accessing comprises accessing the condition from the consumable (see col.19, lines 21-35). Sekizawa discloses accessing a condition associated with an operation of the image forming device from the consumable , see at least col.9, lines 12-40, “ *The integrated monitor unit thus configured periodically gets and retains the status information containing remaining amount information of a consumable article of the machine to be monitored such as a printer (for example, ink, toner, or an ink ribbon) and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information.....* ”, and col.16, line 64-col.17, line 9, which discloses receiving status information via a computer of a printing machine as regards to a balance amount of different consumables, such as ink, toner, ink-ribbon left in the machine. Accessing condition of different variables, that is status information separately from different consumables, such as ink, toner, ink-ribbon corresponds to accessing a condition associated with an operation of the image forming device from the consumable.

Regarding claims 11 and 19, Sekizawa discloses that the accessing comprises accessing the condition related to a status of the consumable and the monitoring comprises monitoring the status of the consumable (see col.19, lines 21-35, Note: Sekizawa discloses accessing the condition related to consumables, such as, toner and ink and then monitoring the quantity of toner or ink.). Also refer to at least col.9, lines 12-40, “ *The integrated monitor unit thus configured periodically gets and retains the status information containing remaining amount information of a consumable article of the machine to be*

Art Unit: 3625

monitored such as a printer (for example, ink, toner, or an ink ribbon) and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information..... “,and col.16, line 64-col.17, line 9 which disclose monitoring and accessing the condition related to the balance amount of different consumables.

Regarding claims 12 and 20, Sekizawa discloses that the accessing comprises condition not related to a status of the consumable (see at least col.5, lines 32-49 which is related to accessing an abnormal state of machine, that is a mechanical failure requiring maintenance which needs dispatching maintenance personnel to fix the repairs).

Regarding claims 13 and 21, Sekizawa discloses that the accessing comprises accessing the condition related to a life span of the image forming device and the monitoring comprises monitoring the life span of the image forming device (see at least col.1, lines 5-18 and col.2, lines 43-49 which suggest monitoring and accessing the operating conditions of the printers for the life span of the installed machines and managed by an agency who has sold these printers (see col.19, lines 6-14).

Regarding claims 14 and 22, Sekizawa discloses that the accessing comprises accessing the condition related to a status of another consumable not having the condition, and the monitoring comprises monitoring the status of the another consumable (see col.19, lines 19-35 which teaches monitoring a plurality of consumables) and col.9, lines 12-40, “ *The integrated monitor unit thus configured periodically*

Art Unit: 3625

gets and retains the status information containing remaining amount information of a consumable article of the machine to be monitored such as a printer (for example, ink, toner, or an ink ribbon) and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information..... ”.

Regarding claims 15, Sekizawa that the accessing comprises accessing a plurality of conditions related to statuses of a plurality of consumables used by the image forming device to form the hard image, and the monitoring comprises monitoring the statuses of the consumables (see col.19, lines 19-35 which teaches monitoring a plurality of consumables) and col.9, lines 12-40, “ *The integrated monitor unit thus configured periodically gets and retains the status information containing remaining amount information of a consumable article of the machine to be monitored such as a printer (for example, ink, toner, or an ink ribbon) and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information..... ”.*

Regarding claims 16 and 23, Sekizawa discloses that the communicating the request comprises communicating the request including an identifier of the image forming device (see at least Fig.17 and col.20-line 55-col.21, line 20 which discloses when sending requests/messages include identifiers, such as the printer's name, serial number and IP address), and further comprising selecting the message from a plurality of other messages using the identifier, and wherein the communicating the message comprises communicating the message after the selecting (see col.19, lines 15-35 which teaches console unit 20 receiving a plurality of messages from a number of

Art Unit: 3625

printers and as analyzed above each message from a particular printer includes the identification details which will be required to enable the console unit 20 to select messages when sending consumables for replenishment or deputing maintenance personnel to fix mechanical repairs to a particular machine). Note: Status information 01, which includes the request message as analyzed above, does include the printer registration log file and further see at least col.35, lines 16-27 which teaches selecting an unread message from a plurality of messages based upon the identity of the printer.

Regarding claims 24 and 29, Sekizawa discloses monitoring the operation of the image forming device with respect to the condition, see col.5, lines 32-50, which disclose the monitoring the operation of the printer for an extended period of time with respect to particular condition, that is if it is a paper jam and is corrected subsequently but if it is an abnormal condition, such as mechanical failure which is not corrected then alerts the user of the printer and dispatches maintenance personnel.

Regarding claim 28, Sekizawa suggest that communicating the message comprises displaying the message using a display of the image forming device, see at least col.20, lines 36-46 which disclose that the status information to be sent to integrated monitor, "20", can be displayed on the screen of local agent "10", wherein the local agent "10" is part of the image forming device, that is printer.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1. Claims 25-26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekizawa in view of Hayward et al. (US Patent 6,798,997) hereinafter referred to Hayward.

Regarding claims 25 and 30, Sekizawa discloses all the limitations of claims 24 and 29, as analyzed above, but does not explicitly teach communicating the request message in response to monitoring detecting the operation of the image forming device triggering the condition. Hayward, in the same field of endeavor, teaches communicating the request message in response to monitoring detecting the operation of the image forming device triggering the condition, see at least col.2, lines 5-63, which teach that if a consumable reaches a threshold status which requires action to replace that is detecting a threshold condition which triggers of a request for purchase or replenishment of that item in time. In view of Hayward, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Sekizawa to incorporate the feature of sending a request message in response to triggering of a condition of the printer because rather than to wait and read the mails about the status of a condition an automatic communication to the resource for

Art Unit: 3625

replenishment of a replacement part or consumable item or to send maintenance personnel for an abnormal failure would result in reducing the downtime of the printer.

Regarding claim 26, Sekizawa discloses all the limitations of claim 9, as analyzed above but does not explicitly teach communicating comprises marketing information regarding purchase of an item associated with the formation of hard images. Hayward, in the same field of endeavor, teaches that comprises marketing information regarding purchase of an item associated with the formation of hard images, see at least col.2, lines 5-63, which teach that if a consumable reaches a threshold status which requires action to replace that is detecting a threshold condition which triggers of a request for purchase or replenishment of that item in time. In view of Hayward, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Sekizawa to incorporate the feature that communicating comprises marketing information regarding purchase of an item associated with the formation of hard images because rather than to wait and read the mails about the status of a condition an automatic communication to the resource for purchase of a part or consumable item would result in reducing the downtime of the printer.

6.2. Claim 27 is rejected under 35 U.S.C. 103(a) as being obvious over Sekizawa in view of Official Notice.

Regarding claim 27, Sekizawa discloses all the limitations of claim 9, as analyzed above but does not explicitly teach that communicating the message comprises printing the message upon paper. The examiner takes Official Notice of the well-known fact of

Art Unit: 3625

printing electronic messages on paper, that is the fact of printing e-mails or other electronic messages on paper is well-known so that the stored message on paper can be stored at convenience and read or referred to later. In view of the Official Notice, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to incorporate the feature of printing the message upon a paper for the obvious well-known reason of storing message on paper and then referring to it or reading it at a later time as per the user's convenience.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(i) US Patent 6,802,659 to Cremon et al. teaches use of RFID tags, locating RFID in a printer's accessory with programmable/usage/media-configuration data and using circuitry to read or write to the reconfiguration data on the RFID tag (see at least col.3, lines 36-51).

(ii) US Patent 6,039,430 to Helterline et al. discloses a method and apparatus for several embodiments: *In one preferred embodiment the replaceable printing component contains marketing related information that is stored by the control portion. In yet another preferred embodiment the replaceable printing component contains maintenance-related information that is stored by the control portion. Another aspect of the present invention is a method for collecting data from an ink jet printing system. The method includes transferring information from the printing system to a memory portion associated with a replaceable printing component. Also included is the step of removing the replaceable printing component from the printing system and reading information in the memory portion transferred from the printing system.* " (see col.2, lines 1-20).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3625

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

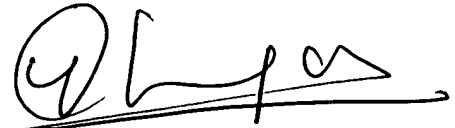
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Yogesh C Garg', with a long horizontal flourish extending to the right.

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
August 15, 2005